

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

DAHIYAT *et al.*

Serial No. 10/632,695

Filing Date: August 1, 2003

For: *Nucleic Acids and Protein Variants of
hG-CSF with Granulopoietic Activity*

Examiner: KEMMERER, Elizabeth

Art Unit: 1646

Confirmation No. 3839

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence, including listed enclosures, is being electronically transmitted in Portable Document Form (PDF) through EFS-Web via Hyper Text Transfer Protocol to the United States Patent and Trademark Office's Patent Electronic Business Center on:

Date: September 26, 2006

Signature:  Brent Yonchara

TERMINAL DISCLAIMER TO
OBVIATE DOUBLE PATENTING REJECTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **Xencor, Inc.** (hereinafter "XENCOR"), represents that it is the assignee of the entire right, title, and interest of:

1. The instant application, U.S. Serial No. 10/632,695, filed August 1, 2003; and
2. U.S. Patent No. 6,627,186, filed January 6, 2000.

An assignment is recorded in the United States Patent and Trademark Office for U.S. Patent No. 6,627,186, at Reel No. 010760, Frame No. 0818. A copy of this assignment are attached hereto.

XENCOR hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of U.S. Patent No. 6,627,186.

XENCOR hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, XENCOR does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,627,186, as shortened by any terminal disclaimer, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee XENCOR.

While Applicants believe that no other fees are due at this time, the Commissioner is authorized to charge the terminal disclaimer fee of \$65.00 under 37 C.F.R. 1.20(d), and any additional fees, including extension fees or any other relief that may be required, in connection with this reply to Deposit Account 50-2319 (Order No. 463077-00241; Docket No.: A-67614-3).

Serial No.: 10/632,695

Filed: August 1, 2003

The undersigned is an attorney or agent of record.

DORSEY & WHITNEY LLP

Dated: _____

By: _____


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Sept. 10, 2006 
Timothy A. Worrall, Reg. No. 54,552 for

Robin M. Silva, Reg. No. 38,304

Attorneys of Record for Applicant



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

NOVEMBER 17, 2000

PTAS

FLEHR HOHBACH TEST, ET AL
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SUITE 3400
SAN FRANCISCO, CA 94111-4187



101509605A

NOTICE

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 04/20/2000

REEL/FRAME: 010760/0818
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

DAHIYAT, BASSIL I.

DOC DATE: 04/13/2000

ASSIGNOR:

LUO, PEIZHI

DOC DATE: 04/13/2000

ASSIGNEE:

XENCOR, INC.
2585 NINA STREET
PASADENA, CALIFORNIA 91107

SERIAL NUMBER: 09479313

FILING DATE: 01/06/2000

PATENT NUMBER:

ISSUE DATE:

SEDLEY PYNE, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

ASSIGNMENT

(NOT ACCOMPANYING APPLICATION)

WHEREAS, the undersigned,

(1) BASSIL I. DAHIYAT, (2) LUO PEIZHI,

(3) _____, (4) _____,

(hereinafter termed "Inventors"), residents of

(1) LOS ANGELES, (2) ARCADIA,

(3) _____, (4) _____,

respectively, Counties of

(1) LOS ANGELES, (2) LOS ANGELES,

(3) _____, (4) _____,

respectively, States of

(1) CALIFORNIA, (2) CALIFORNIA,

(3) _____, (4) _____,

respectively, have invented certain new and useful improvements in

NOVEL NUCLEIC ACIDS AND PROTEINS WITH GRANULOPOIETIC ACTIVITY

and have executed an application for a United States patent disclosing and identifying the invention on the _____ day of _____, and having Serial No. 09/479,313 and filing date of January 6, 1999; and

WHEREAS, XENCOR, INC. a corporation of the State of CALIFORNIA, having a place of business at 2585 NINA STREET, PASADENA 91107-3708, State of CALIFORNIA, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of

Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee this

(1) 13th day of April, 2000 (2) 13th day of April, 2000, respectively.

(1) 
BASIL I. DAHIYAT

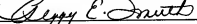
County of Los Angeles

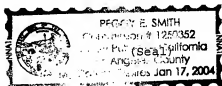
.)
) ss.
)

State of California

On this 13th day of April, in the year 2000, before me, Peggy E. Smith, Notary Public of the State of California, personally appeared (1) BASIL I. DAHIYAT, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he executed the same in his authorized capacity(ies), and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature 



(2) 
PEIZHI LUO

County of Los Angeles

.)
) ss.
)

State of California

On this 13th day of April, in the year 2000, before me, Peggy E. Smith, Notary Public of the State of California, personally appeared (2) PEIZHI LUO, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he executed the same in his authorized capacity(ies), and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature 